

**Remarks:**

This amendment and these remarks are responsive to the Office action dated October 20, 2004. Claims 1-20, 24, and 26-33 are pending in the application. Claims 1-20, 24, and 26-33 are rejected under 35 U.S.C. § 102(e) as being anticipated by Hayward et al. (U.S. Patent No. 6,629,134); claims 1-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cheng et al. (U.S. Patent No. 6,151,643) in view of Perlman et al. (U.S. Patent No. 6,023,585). Applicants hereby submit an additional Declaration under 37 C.F.R. § 1.131 which demonstrates their invention of the claimed subject matter prior to Hayward et al. In view of the enclosed Declaration, and the remarks below, applicants request reconsideration of the rejected claims under 37 C.F.R. § 1.111.

***Rejections under 35 U.S.C. § 102***

Claims 1-20, 24, and 26-33 are rejected under 35 U.S.C. § 102(e) as being anticipated by Hayward et al. (U.S. Patent No. 6,629,134). Applicants note, however, that Hayward et al. did not issue until September 30, 2003 (after Applicants' July 31, 2000 filing date), and that Hayward et al. has an effective date of September 16, 1999 (after Applicants' invention). Applicants thus are submitting an additional Declaration under 37 C.F.R. § 1.131, including selected pages from the lab notebook of Michael Whitmarsh as Exhibit 1, the Declaration demonstrating their invention of the claimed subject matter prior to Hayward et al.

The attached Declaration demonstrates Applicants' conception, prior to September 16, 1999, of an online shopping system that enables a user of a processor system to purchase consumable products for use with a peripheral device of the processor system, including determining the particular type of the peripheral

device without input from the user, informing a remote server system via a communications network of the particular type of peripheral device, and identifying vendors offering to sell consumable products compatible for use with the particular type of peripheral device, as recited in claim 1.

The Declaration also demonstrates conception of a system configured to enable a user of a processor system to locate a vendor selling consumable products for use with a printer of the processor system, where the printer may be any one of plural types, including software executable by the processor system to determine a particular type of the printer without input from the user, and to transmit a purchase request specifying the particular type of the printer via a communications network, and a server system configured to receive the purchase request from the processor system via the communications network, and to identify vendors offering to sell consumable products compatible for use with the particular type of printer, as recited in claim 13.

The Declaration also demonstrates conception of a computer-implemented method of enabling a user of a processor system to purchase ink cartridges for use with a printer of the processor system, where the printer is one of plural types, including detecting a low-ink status in the printer, presenting a user-interface command element to the user in response to the low-ink status, and in response to actuation of the user-interface command element, determining the particular type of the printer, informing a remote server system of the particular type of the printer via a communications network, identifying one or more ink cartridges that are compatible for use with the particular type of printer, and transmitting a purchase invitation to the

processor system via the communications network, where the purchase invitation specifies at least one of the compatible products, as recited in claim 24.

The Declaration also demonstrates conception of a computer-implemented method of enabling a user of a processor system to purchase products for use with a printer of the processor system, where the printer is one of plural types, including receiving a print command from the user, in response to the print command, presenting a user-interface command element to the user, and in response to actuation of the user-interface command element, determining the particular type of the printer, informing a remote server system of the particular type of the printer via a communications network, identifying one or more products that are compatible for use with the particular type of printer, and transmitting a purchase invitation to the processor system via the communications network, where the purchase invitation specifies at least one of the compatible products, as recited in claim 26.

The Declaration also includes attached Exhibits 2, 3, and 4, which demonstrate the diligent pursuit of the creation and commercial implementation of the claimed invention by the inventors and the inventors' assignee from prior to September 16, 1999 to the date of filing of the instant United States patent application.

Applicants suggest that, in view of the enclosed Declaration under 37 C.F.R. § 1.131, the Hayward et al. reference is not available as prior art under 35 U.S.C. § 102(e), and that the rejection of claims 1-20, 24, and 26-33 under 35 U.S.C. § 102(e) thus should be withdrawn.

### ***Rejections under 35 U.S.C. § 103***

Claims 1-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cheng et al. (U.S. Patent No. 6,151,643) in view of Perlman et al. (U.S. Patent No. 6,023,585). Applicants respectfully disagree.

Cheng et al. disclose a method of providing a client computer with access to software updates. More particularly, Cheng et al. discloses a “service provider” downloading a “scanning application” (also referred to as a “client application”) onto a client computer so that the client computer may determine which software applications are stored thereon (See Abstract). Thereafter, upon request by the user (after the user logs in to the service provider), the client application (in consultation with the service provider computer) identifies which of those software applications have available updates (col. 7, lines 54-61). The user then selects which updates he/she wishes to purchase/install and communicates those selections to the service provider (col. 8, lines 21-31). The service provider then provides URL data for the “software vendor computer” (i.e. the manufacturer) to the client application, and the client application downloads the software update (upon the user confirming his/her desire to do so) from the “software vendor computer” (col. 8, lines 32-43).

Cheng et al. fails to disclose determining a particular type of peripheral device of a processor system, and fails to disclose informing a remote server system of the particular type of peripheral device (or of any component of the processor system). Additionally, Cheng et al. in no way discloses identifying “vendors offering to sell consumable products” as recited in claims 1 and 13. In fact, Cheng et al. fails to discuss the purchase of any consumables, disclosing nothing more than providing URL addresses of software makers identified by the user upon selecting software to

be updated. Software is clearly not a consumable product, as software does not suffer wear, and is not consumed with use.

The Perlman et al. reference is also directed to downloading software to a client system. In particular, Perlman et al. discloses downloading device drivers to a client system having plural peripheral devices. Perlman et al. does not identify vendors, but rather simply provides the software download. Neither Cheng et al. nor Perlman et al. disclose the sale of consumable products based on identified peripheral device type.

The Examiner suggests that it would have been obvious to one of ordinary skill in the art to have provided the method of Cheng et al. to have included the teachings of Perlman et al. in order to have allowed the peripherals (such as a printer) of an associated processor system to have been provided with compatible products in a manner consistent with the disclosure of Cheng et al. The Examiner admits that even in combination, Cheng et al. and Perlman et al. fail to disclose consumable products, but suggests it would have been within the level of skill in the art to have specified any compatible product for the particular peripheral device. Applicants disagree, and suggest the Examiner is applying an improper standard for determining obviousness under 35 U.S.C. § 103, and has failed to establish the *prima facie* obviousness of claims 1-20.

In order to establish the *prima facie* obviousness of the rejected claims, the prior art references must teach or suggest each and every claim element. As discussed above, and as admitted by the Examiner, neither Cheng et al. nor Perlman et al. discloses consumable products. Therefore a rejection of claims 1-20

under 35 U.S.C. § 103 is improper, as *prima facie* obviousness has not been established.

Also as required in order to establish the *prima facie* obviousness of the rejected claims, some suggestion or motivation must be found in the cited references themselves to modify the reference or to combine reference teachings as suggested by the Examiner. In providing a rationale for combining and modifying the cited references, the Examiner has simply asserted that "it would have been well within the level of skill in the art to have specified any compatible product for the particular peripheral device", but has failed to identify any specific teaching in the references themselves to support such a rationale.

As set out at MPEP § 2143.01, the mere fact that the references can be combined or modified is not sufficient to establish *prima facie* obviousness. Further, an assertion that the claimed invention is within the capabilities of one of ordinary skill in the art is also not sufficient to establish *prima facie* obviousness:

"...the examiner's comments regarding obviousness amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at appellant's invention because he had the necessary skills to carry out the requisite process steps. This is an inappropriate standard for obviousness." (*Ex parte Levengood*, 28 USPQ2d 1300, Bd. Pat. App. & Inter. 1993).

Applicants suggest that the Examiner has failed to provide a motivation or suggestion to combine and modify the Cheng et al. and Perlman et al. references, other than the guidance provided by Applicants' own specification. Applicants further suggest that the references, even in combination, fail to disclose the subject matter of the rejected claims. Applicants disagree with the Examiner's assertion that it nevertheless "would have been within the level of skill in the art" to incorporate subject matter that is admittedly not disclosed in either cited reference, and suggest

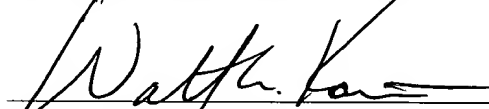
the Examiner has failed to satisfy the requirements for establishing *prima facie* obviousness.

Applicants therefore submit that claims 1-20 are not rendered obvious by the cited references, whether taken singly or in combination, and respectfully request that the rejections of the claims under 35 U.S.C. § 103 be withdrawn.

The above remarks are believed to address fully the Examiner's rejections, and to place the application in condition for allowance. A prompt indication of the same respectfully is requested. The Examiner is encouraged to telephone the undersigned if any issues remain that may be resolved by a telephonic interview.

Respectfully submitted,

KOLISCH HARTWELL, P.C.



Walter W. Karnstein

Registration No. 35,565

Customer No. 23581

520 S.W. Yamhill Street, Suite 200

Portland, Oregon 97204


Telephone: (503) 224-6655

Facsimile: (503) 295-6679

Attorney for Applicants

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on January 20, 2005.



Christie A. Doolittle